

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: April 21, 2022

Mailed: April 25, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Kate Spade LLC

v.

Wolv, Inc.

—
Opposition No. 91241442
—

G. Roxanne Elings of Davis Wright Tremaine LLP,
for Kate Spade LLC.

Amit Agarwal Esq. for Wolv, Inc.

—
Before Cataldo, Bergsman, and Hudis,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Wolv, Inc. (“Applicant”) seeks registration on the Principal Register of the mark WOLV and design, reproduced below, for “wrist watches,” in International Class 14.¹



¹ Application Serial No. 87672203 was filed on November 4, 2017, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s asserted bona fide intention to use the mark in commerce.

The description of the mark reads as follows:

The mark consists of the wording “WOLV” in all capital letters beneath a spade logo. The first letter of “WOLV,” “W” is stylized, resembling two letter “Vs” intersecting at the center. There is a stylized letter “W” within the body of the spade logo.

Color is not claimed as a feature of the mark.

Kate Spade LLC (“Opposer”) filed a Notice of Opposition² against the registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) (likelihood of confusion), Section 43(c) of the Trademark Act, 15 U.S.C. § 1125 (likelihood of dilution), and Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) (lack of a bona fide intent to use the mark in commerce).³ Applicant, in its Answer, denied the salient allegations in the Notice of Opposition.

I. Evidentiary Issues

Before proceeding to the merits of the refusal, we address two evidentiary matters.

² Notice of Opposition, 1 TTABVUE. Citations to the record or briefs in this opinion also include citations to the publicly available documents on TTABVUE, the Board’s electronic docketing system. *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, *2 n.1 (TTAB 2020). The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry.

³ Opposer also pleaded a false suggestion of a connection claim under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a). However, because Opposer did not refer to the false suggestion of a connection claim in its brief, we consider it waived. *See e.g., Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (petitioner’s pleaded descriptiveness and geographical descriptiveness claims not argued in brief deemed waived); *aff’d*, 565 F. App’x 900 (Fed. Cir. 2014) (mem.); *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1426 n.3 (TTAB 2013) (opposer’s pleaded descriptiveness claim not argued in brief deemed waived); *Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1465 n.3 (TTAB 2013) (pleaded claims not argued in its brief deemed waived), *aff’d*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015).

A. Whether Opposer pleaded ownership of Registration No. 4158410.

Opposer, in its Notice of Opposition, pleaded ownership of numerous SPADE Marks consisting of KATE SPADE NEW YORK and design, reproduced below, KATE SPADE, in typed drawing and standard character form, JACK SPADE in standard character form, and a spade design, reproduced below:⁴



Specifically, Opposer pleaded ownership of, inter alia, 12 KATE SPADE NEW YORK and design marks, reproduced above, for a variety of goods. However, Opposer did not identify Registration No. 4158410 in the ESTTA cover sheet for the above-noted mark for “ankle bracelets; bracelets; charms, earrings; jewelry; jewelry boxes, jewelry cases; necklaces; pendants; pins being jewelry; rings; watches,” in International Class 14.⁵

Opposer included Registration No. 4158410 for the mark KATE SPADE NEW YORK and design for, inter alia, watches, as part of Exhibit A of the Notice of

⁴ Notice of Opposition ¶¶ 7 and 10 and Exhibit A (1 TTABVUE 27-28 and 34-42). Only a list of Opposer’s asserted registrations was attached to the Notice of Opposition, not the registrations themselves or their equivalents that may be obtained from the USPTO’s online TESS and TSDR databases.

⁵ Registered June 12, 2012; Sections 8 and 15 declarations accepted and acknowledged.

ESTTA – the Electronic System for Trademark Trials and Appeals – is the Board’s electronic filing system. ESTTA is a web-based application available on the Internet.

Opposition.⁶ The Notice of Opposition corresponds to the complaint in a court proceeding. Trademark Rule 2.116(c), 37 C.F.R. § 2.116(c). In addition, the Board views the ESTTA filing form and the Notice of Opposition as comprising a single document or paper being filed with the Board. *See PPG Indus. Inc. v. Guardian Indus. Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005) (“Since ESTTA’s inception, the Board has viewed the ESTTA filing form and any attachments thereto as comprising a single document or paper being filed with the Board.”). By including Registration No. 4158410 for the mark KATE SPADE NEW YORK and design for goods in International Class 14 in Exhibit A, Opposer put Applicant on notice that it was pleading ownership of that registration. Accordingly, we find that Opposer pleaded ownership of Registration No. 4158410.

B. Whether Opposer’s pleaded registrations are of record.

Opposer is under the mistaken impression that its pleaded registration are automatically of record. In its brief, Opposer stated the following:

In addition to the file history of Opposer’s registrations for the SPADE Marks and opposed application for the SPADE Wolv Mark, which are automatically of record pursuant to 37 C.F.R. § 2.122(b)(1).⁷

However, Opposer’s pleaded registrations are not automatically of record pursuant to 37 C.F.R. § 2.122(b)(1).

⁶ 1 TTABVUE 34.

⁷ Opposer’s Brief, p. 1 (64 TTABVUE 9).

Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), reads as follows (emphasis added):

The file of each application or registration specified in a notice of interference, of each application or registration specified in the notice of a concurrent use registration proceeding, **of the application against which a notice of opposition is filed, or of each registration against which a petition or counterclaim for cancellation is filed** forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose in accordance with paragraph (b)(2) of this section.

A party that wishes to rely on its ownership of a federal registration of its mark that is not the subject of a proceeding before the Board may make the registration of record by offering evidence sufficient to establish that the registration is still subsisting, and that it is owned by the party which seeks to rely on it. This may be done in a number of different ways. For example,

- A federal registration owned by the plaintiff in an opposition or cancellation proceeding, and pleaded by the plaintiff in its complaint, will be received in evidence and made part of the record in the proceeding if the complaint (either as originally filed or as amended) is accompanied by (a) an original or a photocopy of the registration prepared and issued by the Office showing both the current status of and current title to the registration; or (b) a current copy of information from the electronic database records of the Office such as (i) TSDR showing the current status and title (owner) of the registration and, if TSDR does not reflect the current owner of the registration, a copy of information from the Trademark Assignment Recordation Branch database demonstrating an assignment to the current owner of

the registration; or (ii) TESS along with a copy of any records from the Trademark Assignment Recordation Branch database showing an assignment to the current owner of the registration. Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1). *See also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 704.03(b)(1)(A) (2021).

- A federal registration owned by any party to a Board inter partes proceeding will be received in evidence and made part of the record in the proceeding if that party files, during its testimony period, a notice of reliance on the registration, accompanied by (a) a copy of the registration prepared and issued by the Office showing both the current status of and current title to the registration; or (b) a current printout or copy of information from the electronic database records of the Office such as (i) TSDR showing the current status and title (owner) of the registration and, if TSDR does not reflect the current owner of the registration, a printout or copy of the information from the Trademark Assignment Recordation Branch database demonstrating an assignment to the current owner of the registration; or (ii) TESS along with a copy of any records from the Trademark Assignment Recordation Branch database showing an assignment to the current owner of the registration. Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1). *See also* TBMP § 704.03(b)(1)(A).

- Finally, a federal registration owned by any party to a Board inter partes proceeding may be made of record by that party by appropriate identification and introduction during the taking of testimony, that is, by introducing a copy of the registration as an exhibit to testimony, made by a witness having knowledge of the

current status and title of the registration, establishing that the registration is still subsisting, and is owned by the offering party. Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1).⁸ *See also* TBMP § 704.03(b)(1)(A).

Opposer did not take advantage of any of the above-noted means of making its pleaded registrations of record. Accordingly, Opposer's pleaded registrations are not of record. However, Opposer did plead common law rights in the marks KATE SPADE house mark, JACK SPADE, and a spade design reproduced below:



6. Founded in 1993 by the award winning designer Kate Spade, Opposer, including its predecessors-in-interest, launched a collection of handbags bearing the now world-renowned KATE SPADE house mark.

7. Opposer has also used and continues to use the trademark JACK SPADE and the following Spade design: (hereinafter referred to as the "SPADE Logo" and collectively with the KATE SPADE house mark and JACK SPADE trademark referred to herein as the "SPADE Marks").⁹

Thus, Opposer must rely on its common law rights in the KATE SPADE house mark, JACK SPADE, and the spade design mark in the form shown immediately above. *See Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1884 (TTAB 1993) (only mark pleaded by opposer and tried was registered design mark and

⁸ Testimony includes an oral deposition, deposition on written questions, a declaration or an affidavit. Trademark Rule 2.123, 37 C.F.R. § 2.123.

⁹ Notice of Opposition ¶¶ 6-7 (1 TTABVUE 28).

applicant had no notice that opposer intended to rely on use of unregistered word mark appearing on opposer's packaging).

II. The Record

The record includes the pleadings, and pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application. Only Opposer introduced testimony and evidence, and filed a brief.

Opposer introduced the testimony and evidence listed below:

- Notice of reliance on unsolicited media coverage from publications in general circulation;¹⁰
- Notice of reliance on Opposer's advertising in publications in general circulation;¹¹
- Notice of reliance on excerpts from books published by Opposer;¹²
- Notice of reliance on the discovery deposition of William Hsu, Applicant's sole owner and President;¹³

¹⁰ 37-49 TTABVUE. Opposer referred to the exhibits as "unsolicited advertising" presumably because the exhibits display one of Opposer's products as part of an ensemble and lists the price. However, we find that the evidence is unsolicited media coverage because the exhibits are part of lifestyle articles identifying a variety of different products by different manufacturers.

¹¹ 50 and 52 TTABVUE.

¹² 51 TTABVUE.

¹³ 55 TTABVUE. Opposer submitted a condensed version of the deposition with four deposition pages on each sheet. Trademark Rule 2.132(g)(1), 27 C.F.R. § 2.132(g)(1), provides, in pertinent part, "[t]he deposition transcript must be submitted in full-sized format (one page per sheet), not condensed (multiple pages per sheet)."

- Testimony declaration of Kelly Sandoval, the Vice President of Global Marketing for Tapestry, Inc. Opposer is a wholly-owned subsidiary of Tapestry, Inc.¹⁴
- Unsolicited media coverage relating to Opposer's goods under its marks posted on the Internet;¹⁵
- Notice of reliance on an unidentified publication by Digital Luxury Group entitled "World Luxury Index Handbags" that purportedly ranks the renown of luxury handbags;¹⁶
- Notice of reliance on Opposer's annual reports;¹⁷
- Notice of reliance on photographs of billboard advertisements;¹⁸
- Notice of reliance on a photograph of a banner displaying the mark TAPESTRY outside of the New York Stock Exchange banner;¹⁹ and

¹⁴ 56 TTABVUE. The Board posted the portions of the Sandoval declaration Opposer designated as confidential at 59-60 TTABVUE.

¹⁵ 57 TTABVUE and 58 TTABVUE 2-121.

¹⁶ 58 TTABVUE 123-150. Inasmuch as the document does not contain a URL or date the document was accessed, it does not appear to be the type of document admissible through a notice of reliance. *See* Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e). However, because Applicant did not object, we will consider the documents for whatever probative value they may have.

¹⁷ 58 TTABVUE 152-1462. Inasmuch as the document does not contain a URL or date the document was accessed, it does not appear to be the type of document admissible through a notice of reliance. *See* Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e). *See also* *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1717-19 (Fed. Cir. 2012). However, because Applicant did not object, we will consider the documents for whatever probative value they may have.

¹⁸ 58 TTABVUE 1464-67. Inasmuch as the exhibit does not contain a URL or date the document was accessed, it does not appear to be the type of document admissible through a notice of reliance. *See* Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e). However, because Applicant did not object, we will consider the exhibit for whatever probative value it may have.

¹⁹ 58 TTABVUE 1469. Inasmuch as the exhibit does not contain a URL or date the document was accessed, it does not appear to be the type of document admissible through a notice of

- Notice of reliance on excerpts from Opposer’s website (katespade.com).²⁰

III. Entitlement to a Statutory Cause of Action.²¹

Entitlement to a statutory cause of action, formerly referred to as “standing” by the Federal Circuit and the Board, is an element of the plaintiff’s case in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Corcamore*, 2020 USPQ2d 11277 at *4. *See also Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982); *Spanishtown Enters.*, 2020 USPQ2d 11388, at *1.

reliance. *See* Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e). However, because Applicant did not object, we will consider the exhibit for whatever probative value it may have.

²⁰ 58 TTABVUE 1471-1519.

²¹ Even though we now refer to standing as entitlement to a statutory cause of action, our prior decisions and those of the Federal Circuit interpreting “standing” under §§ 1063 and 1064 remain applicable. *See Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

Kelly Sandoval, the Vice President of Global Marketing for Tapestry, Inc., Opposer's parent corporation, testified to the following facts:

- Opposer was founded in 1993;²²
- “By the mid-to-late 1990’s, [Opposer’s] SAM handbag was the ‘it bag.’” We reproduce the SAM handbag below;²³



- “Today, the KATE SPADE brand has grown into a global life and style house offering at least 20 product categories in the United States and around the world, including: (i) watches; (ii) wearable tech (fitness trackers and smart watches); (iii) jewelry; (iv) tech accessories (including phone covers, audio, earbuds and headphones, charging devices and small speakers for home); (v) footwear; (vi) sleepwear; (vii) swimwear; (viii) legwear; (ix) loungewear; (x) jackets; (xi) active wear; (xii) kids apparel and accessories; (xiii) hair accessories; (xiv) fragrances; (xv) home décor

²² Sandoval Testimony Decl. ¶ 4 (56 TTABVUE 4).

²³ *Id.*

(including lighting, bedding, bath and stationery); (xvi) tabletop (including fine china, barware, place settings, casual dining and kitchen items); (xvii) menswear and accessories under the JACK SPADE trademark; (xviii) small leather goods; (xix) bridal; and (xx) and ready-to-wear apparel (including dresses, separates, jackets, outerwear, skirts and pants).”²⁴ and

- “The KATE SPADE trademarks [KATE SPADE house mark, JACK SPADE, and the spade design] have been continuously used and registered in connection with all of [Opposer’s] different product categories. Specifically, the logo, symbolizing the SPADE in KATE SPADE, has been prominently and continuously used in its sales and marketing of virtually all product categories, since the debut of the SAM bag in every season of [Opposer’s] collections.”²⁵

Kelly Sandoval’s testimony that Opposer has used the KATE SPADE house mark and the spade design in connection with a variety of product categories, including, watches, which marks Opposer asserts are similar to the WOLV and spade design sought for registration, proves Opposer has an interest falling within the zone of interests protected by the statute.

In addition, Opposer has a reasonable belief in damage that is proximately caused by registration of the mark because Opposer’s likelihood of confusion claim is not frivolous. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 607 F.2d 1024, 213 UPSQ 185, 189 (CCPA 1982) (plaintiff may establish standing by proving a real commercial

²⁴ *Id.* at ¶ 5 (56 TTABVUE 5).

²⁵ *Id.* at ¶ 8 (56 TTABVUE 6).

interest in its own marks and a reasonable belief that it would be damaged (e.g., a claim of likelihood of confusion that is not wholly without merit)); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (“Petitioner has established his common-law rights in the mark DESIGNED2SELL, and has thereby established his standing to bring this proceeding.”); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112-18 (TTAB 2009) (testimony that opposer uses its mark “is sufficient to support opposer's allegations of a reasonable belief that it would be damaged ...” where opposer alleged likelihood of confusion); *CPC Int’l, Inc. v. Seven-Up Co.*, 218 USPQ 379, 380 (TTAB 1983) (“[O]pposer established its standing to raise the issue [of nonuse] by proving that its assertion of likelihood of confusion was not wholly without merit.”).

Opposer has established its entitlement to bring this opposition proceeding.

Once a plaintiff proves an entitlement to a statutory cause of action on one ground, it has the right to assert any other grounds in an opposition or cancellation proceeding. *See Hole In 1 Drinks, Inc. v. Michael Lajtay*, 2020 USPQ2d 10020, at *3 (TTAB 2020) (once standing shown on one ground, plaintiff has right to assert any other ground in proceeding); *Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017) (if petitioner can show standing on the ground of functionality, it can assert any other grounds, including abandonment); *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1479 (TTAB 2017) (standing established based on surname claim sufficient to establish standing for any other ground).

IV. Priority

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) permits opposition on the basis of ownership of “a mark or trade name previously used in the United States . . . and not abandoned.” We now consider whether Opposer has established its priority of use, a necessary element of any claim under Section 2(d).

As discussed above, because Opposer did not introduce its pleaded registrations into the record, it must prove priority by introducing evidence. Opposer must establish proprietary rights in its pleaded common-law marks (i.e., the KATE SPADE house mark, JACK SPADE, and the spade design) that precede Applicant’s actual or constructive use of its involved mark. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1604 (TTAB 2018) (we must determine “whether Petitioner established ‘proprietary rights in its pleaded common-law mark that precede [Respondent’s] actual or constructive use of its involved mark.’”) (quoting *Executive Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180 (TTAB 2017); *Laramie Corp. v. Talk to Me Programs Inc.*, 36 USPQ2d 1840, 1845 (TTAB 1995). In other words, because unregistered marks are not entitled to the presumptions established under Trademark Act Section 7(b)-(c), it is Opposer’s burden to demonstrate that it owns a trademark that was used prior to Applicant’s first use or constructive use of its mark and not abandoned. *Executive Coach Builders*, 123 USPQ2d at 1180 (citing *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008)).

Applicant's constructive use priority date is November 4, 2017, the date it filed its intent-to-use application to register the WOLV and design mark pursuant to Section 1(b) of the Trademark Act. *See Executive Coach Builders*, 123 USPQ2d at 1180 (citing *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009); and *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008)). Applicant did not introduce any testimony regarding any use prior to November 4, 2017. Therefore, November 4, 2017 is Applicant's priority date.

As noted above, Kelly Sandoval testified that Opposer began using its KATE SPADE mark and the spade design on handbags "[b]y-the mid-to-late 1990's."²⁶ In addition, Sandoval testified to the following:

- The KATE SPADE trademarks have been continuously used and registered in connection with all of [Opposer's] different product categories. Specifically, the logo, symbolizing the SPADE in KATE SPADE, has been prominently and continuously used in its sales and marketing of virtually all product categories."²⁷

- "[Opposer's] continuous use of the  logo since 1993 has the  logo synonymous with the brand."²⁸

- "From 2015-2019, [Opposer's] domestic net sales resulting from only KATE SPADE branded watches totaled over [a substantial amount];²⁹ and

²⁶ Sandoval Testimony Decl. ¶ 4 (56 TTABVUE 4).

²⁷ *Id.* at ¶ 8 (56 TTABVUE 6).

²⁸ *Id.* at ¶ 9 (56 TTABVUE 7).

²⁹ *Id.* at ¶ 10 (56 TTABVUE 7). Because Opposer designated its sales figures confidential, we refer to them in general terms.

- From 2009-2019, [Opposer] dedicated [a significant amount of money] to market its goods bearing the KATE SPADE trademarks, which include the distribution of brand imagery, both in film and in print, digital and social media, outdoor advertising, as well as the production of those assets including public relations efforts and fashion events and presentations.”³⁰

Sandoval’s testimony is sufficient to prove that Opposer used the marks KATE SPADE and the spade logo prior to Applicant’s November 4, 2017 constructive use date. We find that Opposer has proven priority of use in connection with a wide variety of goods, specifically handbags and watches.

V. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as “*DuPont* factors”), *cited in B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567). “Not all *DuPont* factors are

³⁰ *Id.* at ¶ 15 (56 TTABVUE 8). Because Opposer designated its advertising figures confidential, we refer to them in general terms.

relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at *3 (Fed. Cir. 2020) (citing *Dixie Rests.*, 41 USPQ2d at 1533).

“Two key factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because the ‘fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.’” *In re Embiid*, 2021 USPQ2d 577, at *10 (TTAB 2021) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004). *See also In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

For the sake of economy, we confine our analysis to the issue of likelihood of confusion between Applicant’s mark and Opposer’s KATE SPADE mark and the spade design. These are the marks most similar to Applicant’s mark. If we cannot find a likelihood of confusion based on either or both of those marks, we would not find a likelihood of confusion with the JACK SPADE mark. *See In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at *3 (TTAB 2020); *North Face Apparel Corp. v. Sanyang*

Indus. Co., 116 USPQ2d 1217, 1225 (TTAB 2015); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Similarity or dissimilarity and nature of the goods.

Applicant is seeking to register its WOLV and design mark on “wrist watches.” Kelly Sandoval testified that the KATE SPADE trademarks are used on a wide variety of products.

Today, the KATE SPADE brand has grown into a global life and style house offering at least 20 product categories in the United States and around the world, including: (i) watches; (ii) wearable tech (fitness trackers and smart watches); (iii) jewelry; (iv) tech accessories (including phone covers, audio, earbuds and headphones, charging devices and small speakers for home); (v) footwear; (vi) sleepwear; (vii) swimwear; (viii) legwear; (ix) loungewear; (x) jackets; (xi) active wear; (xii) kids apparel and accessories; (xiii) hair accessories; (xiv) fragrances; (xv) home décor (including lighting, bedding, bath and stationery); (xvi) tabletop (including fine china, barware, place settings, casual dining and kitchen items); (xvii) menswear and accessories under the JACK SPADE trademark; (xviii) small leather goods; (xix) bridal; and (xx) and ready-to-wear apparel (including dresses, separates, jackets, outerwear, skirts and pants).³¹

The KATE SPADE trademarks have been continuously used and registered in connection with all of [Opposer’s] different product categories. Specifically, the logo, symbolizing the SPADE in KATE SPADE, has been prominently and continuously used in its sales and marketing of virtually all product categories, since the debut of the SAM bag in every season of [Opposer’s] collections, including:

³¹ Sandoval Testimony Decl. ¶ 5 (56 TTABVUE 4).

- a. on packaging, hangtags and store signage;
- b. throughout the <katespade.com> website;
- c. throughout [Opposer's] social media accounts, including Facebook, Instagram, YouTube, Pinterest and Twitter; and
- d. in connection with products, including within print patterns, leather embossing and cutout design details, on jewelry, shoes, hardware in handbags, and on watch faces.³²

We find Opposer uses the KATE SPADE mark and the spade design on a wide variety of products including jewelry, shoes, handbags, and watches and, therefore, the goods are in part identical.

B. Established, likely-to-continue channels of trade and classes of consumers.

“[Opposer] sells its products online from its website and in retail stores across the country.”³³ As of 2017, Opposer had 250 retail stores across the country including New York City, Chicago, Los Angeles, San Francisco, Seattle, Washington, D.C., Atlanta, and Disney World in Orlando.³⁴ Opposer also sells its products to specialty stores, department stores, and online retailers including Bloomingdale's, Nieman Marcus, Macy's, Belk's, Dillard, Zappos and Amazon.³⁵

Opposer advertises extensively.

Opposer has placed advertisements in over 70 widely circulated print and digital editions of national publications, such as *Vogue*, *InStyle*, *Marie Claire*, *Vanity*

³² Sandoval Testimony Decl. ¶ 8 and Exhibits 1 and 2 (56 TTABVUE 5 and 29-48).

³³ Sandoval Testimony Decl. ¶ 11 (56 TTABVUE 6).

³⁴ Sandoval Testimony Decl. ¶ 13 and Exhibit 1 (56 TTABVUE 6 and 29-34).

³⁵ Sandoval Testimony Decl. ¶ 13 (56 TTABVUE 6-7).

Fair, Elle, Harper's Bazaar, Esquire, Glamour, and W, since 2012 through the present. In addition, it has placed advertisements in regional magazines such as *New York Magazine, Los Angeles Magazine* and *Ala Moana* in Hawaii. Kate Spade's national marketing campaigns have featured supermodels the likes of Karlie Kloss, Fernanda Ly and Jourdan Dunn and celebrities such as Bryce Howard and fashion icon Iris Apfel.³⁶

As noted above, Opposer has an extensive presence on social media, such as Facebook, Instagram, Pinterest, Twitter, Tumblr, YouTube, and Snapchat.³⁷

Applicant is seeking to register its mark for "wrist watches" without any limitations or restrictions as to channels of trade, classes of consumers, or price. Thus, we presume that Applicant's goods move in all channels of trade normal for such goods and that they will be purchased by all potential customers for such goods, including the channels of trade in which Opposer offers its products and the potential customers to whom Opposer offers its products. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

C. The strength of Opposer's KATE SPADE trademark and spade design.

³⁶ Sandoval Testimony Decl. ¶ 17 (56 TTABVUE 8).

³⁷ Sandoval Testimony Decl. ¶ 22 (56 and 59 TTABVUE 9). Because Opposer designated as confidential the extent of its social media followers and viewers, we refer to it in general terms.

To determine a mark's strength, we consider its inherent strength, based on the nature of the mark itself, and its commercial strength, based on its marketplace recognition. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength ..."); *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017); *Top Tobacco, L.P. v. N. Atlantic Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (market strength is the extent to which the relevant public recognizes a mark as denoting a single source); 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. March 2022 update) ("The first enquiry is for conceptual strength and focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use.").

Commercial strength may be measured indirectly, by volume of sales and advertising expenditures and factors such as length of use of the mark, widespread critical assessments, notice by independent sources of the goods or services identified by the mark, and general reputation of the goods or services. *Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014).

1. Inherent strength

The relevant marks at issue are KATE SPADE and the spade design reproduced below:³⁸



The name Kate Spade and the spade design have no descriptive or geographic meaning when used in connection with the various consumer items on which Opposer uses the marks. Therefore, Opposer's marks are arbitrary marks and inherently strong. *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004) (defining an arbitrary mark as a "known word used in an unexpected or uncommon way" and observing that such marks are typically strong). *See also Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (arbitrary terms are conceptually strong trademarks); *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1479 (TTAB 2007) (completely unique and arbitrary, if not coined, nature of mark in relation to goods entitles the registered mark to a broad scope of protection, and significantly increases the likelihood that the marks, when used in connection with the identical goods would cause confusion).

³⁸ As we noted above, the solid spade design is the only common law design mark asserted in the Notice of Opposition. Because Applicant was not otherwise placed on notice, Opposer cannot expand upon the common law spade design marks that Opposer made of record or cited in its brief and appendix. *See Riceland Foods*, 26 USPQ2d at 1884.

2. Commercial strength

Opposer pleaded and argued that its KATE SPADE mark and the spade design are famous.³⁹ Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales of and advertising expenditures for the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1305-06 and 1309. Raw numbers alone may be misleading, however. Thus, some context in which to place raw statistics may be necessary, for example, market share or sales or advertising figures for comparable types of goods. *Id.* at 1309. Other contextual evidence probative of the renown of a mark may include the following:

³⁹ Notice of Opposition ¶¶ 6, 12, 15, and 25 (1 TTABVUE 28-31); Opposer’s Brief, pp. 3-14 (64 TTABVUE 11-22).

- extent of catalog and direct mail advertising, email blasts, customer calls, and use of social media platforms, such as Twitter, Instagram, Pinterest, and Facebook, identifying the number of followers;

- the number of consumers that Opposer solicits through its advertising throughout the year;

- local, regional, and national radio and television advertising campaigns, free-standing print campaigns, and mentions in national publications;

- unsolicited media attention; and

- product placement in television and in movies.

Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co., 908 F.3d 1315, 128 USPQ2d 1686, 1690-91 (Fed. Cir. 2018).

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, Opposer has the duty to clearly prove the fame of its mark. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007)).

In the likelihood of confusion analysis, “fame ‘varies along a spectrum from very strong to very weak.’” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)).

With this framework in mind, we turn to Opposer’s evidence of fame.

a. Advertising and publicity

Opposer has spent a substantial amount of money marketing products with the KATE SPADE mark and the spade design over the past ten years.⁴⁰

[Opposer] has placed advertisements in over 70 widely circulated print and digital editions of national publications, such as *Vogue*, *InStyle*, *Marie Claire*, *Vanity Fair*, *Elle*, *Harper's Bazaar*, *Esquire*, *Glamour*, and *W*, since 2012 through the present. In addition, it has placed advertisements in regional magazines such as *New York Magazine*, *Los Angeles Magazine* and *Ala Moana* in Hawaii. Kate Spade's national marketing campaigns have featured supermodels the likes of Karlie Kloss, Fernanda Ly and Jourdan Dunn and celebrities such as Bryce Howard and fashion icon Iris Apfel.⁴¹

Like many fashion brands, [Opposer] promotes its new fashion offerings by presenting them in a runway fashion show generally held at least twice a year. These fashion shows are attended by celebrities, such as Zosia Mamet, Olivia Culpo and Jourdan Dunn and all major fashion media outlets such as *Vogue*, *Refinery29*, *Elle*, *InStyle*, *Fashionista*, *Harper's Bazaar* and *W Magazine*, as well as new media outlets, including bloggers such as Man Repeller and Julia Engel, who have millions of followers on Instagram, Twitter and other channels.⁴²

In addition, Kate Spade often engages in outdoor advertising with the use of billboards in high-density and geographically diverse locations such as the SoHo neighborhood of New York City, the Sunset Boulevard in

⁴⁰ Sandoval Testimony Decl. ¶ 15 (59 TTABVUE 8) (confidential). Because Opposer designated its advertising expenditures as confidential, we refer to the number in general terms.

⁴¹ Sandoval Testimony Decl. ¶ 17 (56 TTABVUE 8). *See also* 50 and 52 TTABVUE.

⁴² Sandoval Testimony Decl. ¶ 19 (56 TTABVUE 8-9).

Los Angeles, Highland Village in Houston Texas, and Charlotte, North Carolina.⁴³

This has undoubtedly driven a significant number of visitors to its website.⁴⁴

Opposer advertises on third party websites, as well as on the major social media platforms, such as Facebook, Instagram, Pinterest, Twitter, Tumblr, and Snapchat.⁴⁵

Opposer's social media platforms have millions for followers.⁴⁶

“[Opposer] has recruited outside agencies to conduct market surveys to measure aided awareness of the KATE SPADE brand – *i.e.*, the participant giving an affirmative answer when asked if she has heard of KATE SPADE – and unaided awareness of the KATE SPADE brand – *i.e.*, the participant names KATE SPADE when asked the first fashion brand that comes to mind. [Opposer] then relies on those surveys to make create [sic] marketing strategy.”⁴⁷ The participants of these market surveys recognize the KATE SPADE brand.⁴⁸

As a result of Opposer's advertising and marketing, “Gartner, Inc. and its predecessor L2, Inc. (“L2/Gartner”)—the global standard for measuring digital competence by analyzing 1,250 data points across Site & E-Commerce, Digital

⁴³ Sandoval Testimony Decl. ¶ 20 (59 TTABVUE 9).

⁴⁴ Sandoval Testimony Decl. ¶ 12 (59 TTABVUE 7) (confidential). Because Opposer designated the visitors to its website as confidential, we refer to the number in general terms.

⁴⁵ Sandoval Testimony Decl. ¶ 22 (56 TTABVUE 9).

⁴⁶ Sandoval Testimony Decl. ¶ 22 (59 TTABVUE 10). Because Opposer designated the number of followers on its social media platforms as confidential, we refer to the number in general terms.

⁴⁷ Sandoval Testimony Decl. ¶ 16 (56 TTABVUE 8).

⁴⁸ Sandoval Testimony Decl. ¶ 16 (confidential). Because Opposer designated the surveys as confidential, we refer to the results in general terms.

Marketing, Social Media, and Mobile across different industries—has, since 2011, consistently ranked Kate Spade as one of the top fashion brands.”⁴⁹

Opposer has received numerous awards for the quality of its products and social media presentations.⁵⁰

b. Sales under the KATE SPADE mark and the spade logo.

From 2009 through 2019, Opposer’s domestic net sales of products bearing the KATE SPADE and the spade design have been in the billions⁵¹ and its domestic net sales for KATE SPADE branded watches have been in the millions.⁵²

At the end of 2013, Kate Spade had 118 retail stores across the U.S., which had grown to approximately 250 stores by 2017, one of which is located at the Walt Disney World Resort. Today, as Kate Spade shifts to digital platforms to deliver Kate Spade branded products, it retains over 200 retail shops and outlet stores across the United States. Kate Spade also sells wholesale to specialty stores and major department stores, which have included Bloomingdales, Neiman Marcus, Macy’s, Belk’s and Dillard’s. Kate Spade’s third-party retailers sell KATE SPADE-branded merchandise in their retail locations and through their websites. Kate Spade also sells its goods through online retailers, including Zappos and Amazon.⁵³

c. Actual recognition of the marks

Perhaps the most significant evidence for analyzing fame is the extent of actual public recognition of the mark as a source-indicator for the goods or services in

⁴⁹ Sandoval Testimony Decl. ¶ 27 (56 TTABVUE 11).

⁵⁰ Sandoval Testimony Decl. ¶ 28 (56 TTABVUE 12-14).

⁵¹ Sandoval Testimony Decl. ¶ 10 (59 TTABVUE 7). Because Opposer designated its revenues as confidential, we refer to them in general terms.

⁵² *Id.*

⁵³ Sandoval Testimony Decl. ¶ 13 (56 TTABVUE 6-7).

connection with which it is used. *Cf. TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1104 (TTAB 2018) (quoting *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1024 (TTAB 2011)).

The millions of visitors to Opposer’s website and other social media platforms evidences widespread recognition of Opposer’s marks by a substantial fraction of the United States population.⁵⁴

“[Opposer] garners significant media attention, as demonstrated in monthly reports showing mentions in magazines and on digital sites. These mentions include both editorials featuring KATE SPADE branded products, as well as celebrities wearing the KATE SPADE product.”⁵⁵ Opposer introduced numerous lifestyle news articles identifying a KATE SPADE product as part of a fashion ensemble.⁵⁶ For example, CNN.com reported that Opposer’s products were “the label to buy when one is ready to shift from no-name-brands to designer.”⁵⁷

The unsolicited media coverage listed as part of the record demonstrates that the KATE SPADE name is a well-known, commercially strong trademark.⁵⁸ In addition, there is some evidence that fashion writers recognize the spade design as a commercially strong mark. For example (emphasis added),

⁵⁴ Sandoval Testimony Decl. ¶ 22 (59 TTABVUE 10).

⁵⁵ Sandoval Testimony Decl. ¶ 29 (56 TTABVUE 14). *See also* 37-49 TTABVUE.

⁵⁶ 37-49 TTABVUE.

⁵⁷ 57 TTABVUE 22.

⁵⁸ *See e.g.*, CNN Style website (CNN.com) (July 2018) (“Kate Spade the brand ... launched in 1993 and became synonymous with entry-level fashionistas everywhere.”) (57 TTABVUE 22). *See* the dilution fame analysis for a detailed discussion of the renown of Opposer’s marks.

- Design Rush website (designrush.com)

Kate Spade New York is now a global lifestyle brand that inspires colorful living through their handbags, clothing, jewelry, shoes, stationery, eyewear fragrance, home décor, bedding and gifts. Although the ownership has changed hands, the logo still reflects the originality and creativity of the founder. Their logo design marries the luxury retail space with the company's spirited approach to fashion, commitment to curiosity, and passion for sharing a colorful world.

The logo design is simple, minimal and quirky. It features a small spade – exactly the same one as the shape found on the suit of spades in a pack of cards. The logo is representative of not just the surname of the brand's founder, but also the label's love of simple shapes and unique designs.⁵⁹

Kate Spade is a classic logo design in the E-commerce & Retail, Fashion & Beauty and Luxury Industries.⁶⁰

- Prestige website (prestigeonline.com) (July 2020)

Going back to its symbol for inspiration, Kate Spade launches its latest Signature Collection

The spade logo is iconic. It is used in various applications in all categories in every season of Kate Spade's collections. From bold to subtle and through unusual applications, the spade is always present.⁶¹

- Real Simple website (realsimple.com) (February 2019)

Everything is 30% Off at Kate Spade Right Now – Shop the 8 Bags We're Obsessed With

From the mind of Kate Spade's creative director Nicola Glass – who's known for her Kate Spade creations that

⁵⁹ 57 TTABVUE 19.

⁶⁰ 57 TTABVUE 20.

⁶¹ 57 TTABVUE 26.

mold **the brand's signature spade symbol** with unique prints and colors – comes a beautiful spring collection that we can't get enough of.⁶²

- Transform Magazine website (transformmagazine.com) (February 2019)

Kate Spade rebrands in pink spades and green shades

Fashion house and lifestyle brand Kate Spade has announced a new identity with the launch of its spring 2019 collection blending pink and the **brand's iconic spade**.⁶³

- Harper's Bazaar Magazine (harpersbazaararabia.com) (April 2019)

What 4 Bazaar Editors Are Buying From Kate Spade This Season

“SS19 is all about pretty pops of colour and there are few better ways to achieve this than with a chic red shoulder bag. I love the contrast of pin and red in the Nicola Twistlock bag and how the **brand's iconic spade symbol** is cleverly integrated as the primary motif.” – Connie Chamberlayne, Content Editor⁶⁴

- SSI Life blog (ssilife.com) (July 2020)

Kate Spade New York Signature Handbag Collection Fall 2020

When Creative Director Nicola Glass first joined Kate Spade in new york [sic] in 2018, she was inspired by the shape of the heart that is found naturally within the spade symbol, the center of the brand's iconography.

⁶² 57 TTABVUE 30.

⁶³ 57 TTABVUE 34.

⁶⁴ 57 TTABVUE 36.

Pulling inspiration from the **brand's iconic spade symbol**, we are excited to launch a new collection of handbags for Fall 2020.⁶⁵

We find that Opposer's KATE SPADE mark and spade logo are very strong marks along the spectrum of from very weak to very strong.

Because the KATE SPADE mark and the spade design are both inherently strong and commercially strong, those marks are entitled to a broad scope of protection.

D. The similarity or dissimilarity of the marks.

We now turn to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.") (citation omitted).

In comparing the marks, we are mindful that where, as here, the goods are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs.*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enters. Inc. v. Rind*,

⁶⁵ 57 TTABVUE 42.

85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Prod. Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). We keep in mind that “[s]imilarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)).

Applicant is seeking to register the mark WOLV and design reproduced below:



Opposer uses the marks KATE SPADE and the spade design reproduced below:



The marks are similar because they include either a spade design or in the case of the mark KATE SPADE, the word “Spade.” However, when we consider Applicant’s

mark in its entirety, we find the marks are more dissimilar than similar. We find the dominant element of Applicant's mark is the word "Wolv." "In the case of marks, such as Applicant's, consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods." *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012)); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). That is because "[t]he word portion of a word and design mark 'likely will appear alone when used in text and will be spoken when requested by consumers.'" *Id.* (quoting *Viterra*, 101 USPQ2d at 1911).

There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Viterra*, 101 USPQ2d at 1908; *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Accordingly, we disagree with Opposer's contentions that (i) because the spade design is a common element, consumers will perceive it to be the dominant feature of the marks,⁶⁶ (ii) because the spade design is above the name Kate Spade in Opposer's mark and the word "Wolv" in Applicant's mark, the spade design is the dominant

⁶⁶ Opposer's Brief, p. 21 (64 TTABVUE 29).

portion of those marks,⁶⁷ and (iii) “consumers are likely to ‘read’ what they see, regardless of what the word below the design [WOLV] actually says.”⁶⁸ All of these contentions as to how consumers would perceive Applicant’s mark comprise mere arguments of counsel without supporting proof. “Attorney argument is no substitute for evidence.” *Cai v. Diamond Hong*, 127 USPQ2d at 1799 (quoting *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)).

We again point out that Opposer failed to introduce its pleaded registrations into the record and it pleaded ownership of the common law KATE SPADE house mark, not the KATE SPADE NEW YORK and design mark it purportedly registered. The KATE SPADE house mark does not include the spade design and, therefore, for this additional reason, Opposer’s contentions are inapposite.

We also are unpersuaded by Opposer’s argument that Applicant intends the spade design to be the dominant element of its mark because Applicant prepared renderings of sample watches that feature the spade logo as a stand-alone mark and ornamentation.⁶⁹ Applicant’s spade design is not the subject of the application being

opposed. The mark at issue is . We focus our analysis on the mark sought to be registered, not on how Applicant may use the spade design on proposed watches. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 UPSQ2d 1687, 1690 n.4 (Fed. Cir. 1993)

⁶⁷ Opposer’s Brief, p. 22 (64 TTABVUE 20).

⁶⁸ Opposer’s Brief, p. 22 (64 TTABVUE 30).

⁶⁹ Opposer’s Brief p. 21 (64 TTABVUE 29) (citing Hsu Discovery Dep., Exhibits 7, 8 and 12 (55 TTABVUE 107-154 and 192)).

(indicating that applicant's assertions that the applied-for mark would appear with applicant's house mark were not considered in the likelihood-of-confusion determination); *Denney v. Elizabeth Arden Sales Corp.*, 263 F.2d 347, 120 USPQ 480, 481 (CCPA 1959) ("In determining the applicant's right to registration, only the mark as set forth in the application may be considered"); *Bellbrook Dairies, Inc. v. Hawthorn-Mellody Farms Dairy, Inc.*, 253 F.2d 431, 117 USPQ 213, 214 (CCPA 1958) ("The fact that each of the parties applies an additional name or trademark to its product is not sufficient to remove the likelihood of confusion.

The right to register a trademark must be determined on the basis of what is set forth in the application rather than the manner in which the mark may be actually used."); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) ("[W]e do not consider how [the parties] actually use their marks in the marketplace, but rather how they appear in the registration[s]. We must compare the marks as they appear in the drawings, and not on any [packaging] that may have additional wording or information."). *Cf. In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1412 (TTAB 2015), *aff'd.*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017) ("In considering the similarity between the marks, we must compare Applicant's mark with the cited mark as shown in the registration certificate.").

Turning to Opposer's pleaded spade logo, we find Applicant's  mark

is not so similar to Opposer's  logo that consumers will perceive the marks as emanating from the same source despite the inherent and commercial strength of

Opposer's spade logo. Because the marks must be compared in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *DuPont*, 177 USPQ at 567; *Nat'l Data Corp.*, 224 UPSQ at 751. See also *Franklin Mint Corp. v. Master Mfg. Co.*, 67 F.2d 1005, 212 UPSQ 233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.").

That holds true here, where Applicant's composite mark contains the prominent word "Wolv." We would run afoul of the principle that we compare the marks in their entireties were we to ignore the word "Wolv." Even though the design elements of both marks are spade designs, the visual distinctions between the designs along with Applicant's addition of the word "Wolv" create visually dissimilar marks that engender different commercial impressions.

Focusing on the spade designs, Opposer's asserted spade logo is solid black and resembles the spade displayed on playing cards. As noted above, consumers may associate Opposer's spade logo with the Kate Spade's surname. In contrast, Applicant's spade logo is more ornate and is composed of an outline of a spade with a highly stylized letter "W" in the middle that consumers are likely to associate with the word "Wolv."

We do not suggest that purchasers will parse out these features separately, or recall them specifically. We do not place the marks side-by-side in our analysis, but consider the marketplace, the consumer's hazy recollection, and the overall

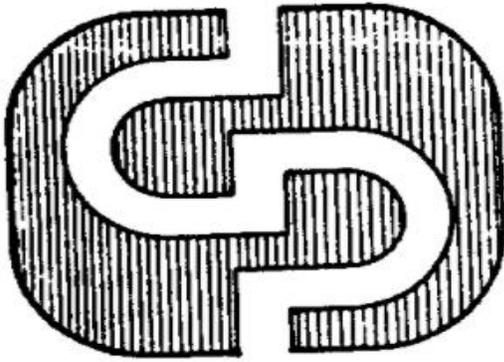
impressions made by each parties' spade design, which we find readily distinguishable. Further, we compare the marks in terms of their overall appearances, pronunciation, connotation and commercial impressions, and conclude that there is no likelihood that consumers will confuse the source of each parties' goods based on the marks. *Cf. In re Electrolyte Labs. Inc.*, 929 F.2d 645, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ reproduced below is not similar to K+EFF reproduced below);



In re TSI Brands, 67 USPQ2 1657 (TTAB 2002) (AK AMERICAN KHAKIS and design reproduced below is not similar to the stylized letters AK and design);



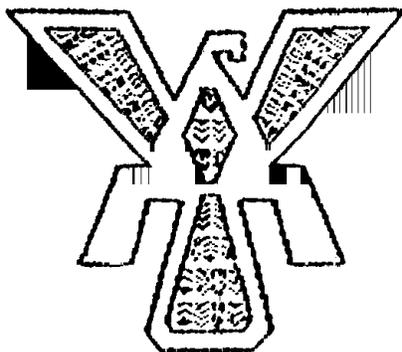
Georgia-Pacific Corp. v. General Paper Corp., 196 USPQ 762, 772 (TTAB 1977) (the stylized letters GP and design reproduced below is not similar to the stylized letters GP and design reproduced below);



We turn now to the comparison between Applicant's  WOLV mark and Opposer's KATE SPADE mark. As noted above, the similarity between Opposer's KATE SPADE mark and Applicant's WOLV and design mark is that the design portion of Applicant's mark is a spade. In some cases, words and pictures that designate the same thing often have similar meanings (word-design equivalency). See *Izod Ltd. v. Zip Hosiery Co.*, 405 F.2d 575, 160 USPQ 202, 203 (CCPA 1969) (TIGER HEAD is similar to a tiger design); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (PENGUIN is similar to a penguin design); *Squirrel Brand Co. v. Green Gables Inv. Co.*, 223 USPQ 154, 155 (TTAB 1984) (SQUIRREL BRAND is similar to a squirrel design).

However, as discussed above, when we consider Applicant's mark in its entirety, the dominant portion of the mark is the word "Wolv" and consumers may associate the stylized letter "W" within the spade design with the term "Wolv." The case before us is somewhat similar to *Eagle Clothes, Inc. v. Robert Lewis Inc.*, 165 USPQ 266, 268 (TTAB 1970), where the Board did not find the marks similar considering the differences between the highly stylized bird design sought to be registered,

Applicant's Mark



Registrant's Marks



Silver Eagle 

Golden Eagle 



We find that the marks are not similar.

E. Conclusion

After considering Opposer's arguments and evidence as they pertain to the relevant *DuPont* likelihood of confusion factors, although the goods are in part identical, we presume the parties will offer the goods in the same channels of trade to the same classes of consumers, and Opposer's marks are very strong, we find the

marks are so dissimilar in their entireties that there is no likelihood of confusion. *See Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998) (finding that despite the fact the marks were used for the same class of goods and that the goods traveled in the same trade channels and were purchased by the same or similar customers, the mark CRISTAL for champagne and the mark CRYSTAL CREEK for wine differed in appearance, sound, significance, and commercial impression); *Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 UPSQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *DuPont* factor may not be dispositive.”).

We dismiss the Section 2(d) likelihood of confusion claim.

VI. Dilution

Opposer alleges dilution by both blurring and tarnishment,⁷⁰ but, in its brief, argues only that Applicant’s mark is likely to blur the distinctiveness of Opposer’s marks.⁷¹ To prevail, Opposer must show that: (1) it owns a famous mark which is distinctive; (2) Applicant is using a mark in commerce which allegedly dilutes Opposer’s famous mark; (3) Applicant’s use of its mark began after Opposer’s became famous; and (4) Applicant’s use of its mark is likely to cause dilution by blurring. *N.Y. Yankees P’ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1502 (TTAB 2015) (citing *Coach Servs.*, 101 USPQ2d at 2012).

⁷⁰ Notice of Opposition ¶ 28 (1 TTABVUE 31) (“Applicant’s Mark is likely to blur and/or tarnish the positive associations of Opposer’s SPADE Marks.”).

⁷¹ Opposer’s Brief, pp. 27-28 (64 TTABVVUE 35-36).

A. Whether Opposer owns distinctive, famous marks for purposes of analyzing Opposer's dilution claim.

There is no dispute that Opposer's KATE SPADE mark and the spade logo are distinctive, both inherently, and commercially as a result of widespread use and consumer recognition. Conceptually, they are coined, arbitrary symbols. Applicant does not dispute that the marks are inherently distinctive.

As for whether the marks are sufficiently "famous" to be entitled to protection against dilution, we must determine whether they are "widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." *N.Y. Yankees P'ship*, 114 USPQ2d at 1502 (quoting 15 U.S.C. § 1125(c)(2)(A)). By using the "general consuming public" as the benchmark, the TDRA eliminated the possibility of "niche fame," which some courts had recognized under the previous version of the statute. *Coach Servs.*, 101 USPQ2d at 1724. In assessing fame for dilution, we consider:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

15 U.S.C. § 1125(c)(2)(A).

Fame for likelihood of confusion and fame for dilution are distinct concepts, and dilution fame requires a more stringent showing. *Coach Servs.*, 101 USPQ2d at 1724. While fame for dilution “is an either/or proposition” — it either exists or does not — fame for likelihood of confusion is a matter of degree along a continuum. *Palm Bay*, 73 USPQ2d at 1694 (quoting *Coors Brewing*, 68 USPQ2d at 1063). Accordingly, a mark can acquire “sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame.” *Coach Servs.*, 101 USPQ2d at 1724 (quoting *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1722 (TTAB 2007)).

Dilution fame is difficult to prove. *Coach Servs.*, 101 USPQ2d at 1724 (citing *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180 (TTAB. 2001) (“Fame for dilution purposes is difficult to prove.”); and *Everest Capital Ltd. v. Everest Funds Mgmt. LLC*, 393 F.3d 755, 73 USPQ2d 1580, 1585 (8th Cir. 2005) (“The judicial consensus is that ‘famous’ is a rigorous standard.”)).

To establish the requisite level of dilution fame, the “mark’s owner must demonstrate that the common or proper noun uses of the term and third-party uses of the mark are now eclipsed by the owner’s use of the mark.” *Coach Servs.*, 101 USPQ2d at 1725 (quoting *Toro*, 61 USPQ2d at 1180). An opposer must show that, when the general public encounters the mark “in almost any context, it associates the term, at least initially, with the mark’s owner.” *Id.* In other words, a famous mark is one that has become a “household name.” *Coach Servs.*, 101 USPQ2d at 1724 (quoting *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 72 USPQ2d 1078,

1083 (9th Cir. 2004) (quoting *Thane Int. Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 64 USPQ2d 1564, 1575 (9th Cir. 2002))). Fame for purposes of dilution applies to a select class of marks that are truly renowned.

The party claiming dilution must demonstrate by the evidence that its mark is truly famous. In effect, an owner of a famous mark is attempting to demonstrate that the English language has changed. ... However, to accomplish this successfully, the mark's owner must demonstrate that the common or proper noun uses of the term and third-party uses of the mark are now eclipsed by the owner's use of the mark. What was once a common noun, a surname, a simple trademark, etc., is now a term the public primarily associates with the famous mark. To achieve this level of fame and distinctiveness, the party must demonstrate that the mark has become the principal meaning of the word. For example, the mark DUPONT was recognized as a mark that could be protected under the FTDA and would not be treated as merely a surname. H.R. REP. No. 104-374, at 3 (1995) (“[T]he use of DUPONT shoes ... would be actionable under this legislation”). On the other hand, the plaintiff in the *Hasbro* case could not show that the English language had changed, and that purchasers associated the common word CLUE *in the abstract* with the producer of the board game.

Therefore, an opposer relying on the FTDA to provide the broadest protection for its mark against totally unrelated goods, as in this case, must provide evidence that when the public encounters opposer's mark in almost any context, it associates the term, at least initially, with the mark's owner.

Toro, 61 USPQ2d at 1180-81 (internal citation omitted).

We discussed the evidence of fame of Opposer's marks above in our analysis of the commercial strength of Opposer's marks.

By any and all measures, KATE SPADE is a famous trademark and is entitled to protection against dilution under 15 U.S.C. § 1125(c). However, the renown of the

spade logo is not so clear cut. Unlike the WAVE and ACCOUSTIC WAVE marks in *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1306-07, we are faced with a record where virtually every reference to the spade design is joined with a reference to the KATE SPADE word mark. With the exception of a few fashion writers who made note of the spade logo (discussed above) and the products on which Opposer has used the spade design as ornamentation, Opposer presents consumers little in the way of independent advertising or other promotional materials of the spade design alone. Because Opposer has not introduced evidence presenting consumers with an independent reference to the spade design apart from the KATE SPADE word mark, consumers do not have a basis to disassociate the spade design from the KATE SPADE word mark. *Cf. Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1308 (“[C]onsumer awareness of the product mark apart from the fame of the associated house mark, whether demonstrated directly or indirectly, is a reliable test of the independence of the product mark from its parent house mark.”).

We find Opposer failed to establish that its use of the spade design is as a symbol the public primarily associates as Opposer’s famous mark such that it eclipses the common use of a spade design. *Coach Servs.*, 101 USPQ2d at 1725 (quoting *Toro*, 61 USPQ2d at 1180). In other words, Opposer has not proven its spade design is a “household symbol” such that when the public encounters Opposer’s spade design in almost any context, the public associates the spade design, at least initially, with Opposer.⁷²

⁷² Also, with the exception of the news article at 57 TTABVUE 46-58, the news articles and blogs referring to the renown of the spade design were dated after the November 4, 2017

We therefore find that KATE SPADE is famous for dilution purposes but that the spade design is not famous for dilution purposes. Because the spade design is not famous for purposes of dilution, we continue our dilution analysis only with respect to the KATE SPADE word mark.

B. Whether Applicant is using its WOLV and design mark in commerce.

The second dilution element Opposer must establish is that Applicant is using its allegedly diluting mark in commerce. The Board has previously held that, under the 1999 amendments to the Federal Trademark Dilution Act, an application based on intent to use a mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), satisfies the “in commerce” requirement. *Toro Co.*, 61 USPQ2d at 1174. *See also N.Y. Yankees P’ship*, 114 USPQ2d at 1505. The Trademark Dilution Revision Act of 2006 (TDRA) does not change this result. *See N.Y. Yankees P’ship*, 114 USPQ2d at 1505-06 (citing *Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2023 (TTAB 2014) (holding that an opposer asserting a dilution claim in a Board proceeding against an application based on an allegation of actual use in commerce pursuant to Section 1(a) may prove applicant's use in commerce by direct evidence or rely on the application filing date as the date of constructive use)).

Because Applicant filed an intent to use application, Opposer has satisfied the second dilution element.

filing date of Applicant’s application. Therefore, it is not clear whether Opposer’s spade design was famous for dilution purposes prior to that date. See 57 TTABVUE 2-148.

C. Opposer's KATE SPADE mark was famous before Applicant's constructive filing date.

Based on Kelly Sandoval's testimony regarding Opposer's revenues and advertising expenditures and the extensive unsolicited media coverage in magazines in general circulation,⁷³ we find the KATE SPADE mark was famous before the filing date of Applicant's application, November 4, 2017.

D. Whether Applicant's use of its WOLVE and design mark is likely to cause dilution by blurring.

Dilution by blurring is "an association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." *Coach Servs.*, 101 USPQ2d at 1724 (quoting 15 U.S.C. § 1125(c)(2)(B)). It "occurs when a substantial percentage of consumers, on seeing the junior party's mark on its goods, are immediately reminded of the famous mark and associate the junior party's mark with the owner of the famous mark, even if they do not believe that the goods emanate from the famous mark's owner." *N.Y. Yankees P'ship*, 114 USPQ2d at 1509.

The concern is that "the gradual whittling away of distinctiveness will cause the trademark holder to suffer 'death by a thousand cuts.'" *Nat'l Pork Board v. Supreme Lobster and Seafood Co.*, 96 USPQ2d 1479, 1497 (TTAB 2010) (citation omitted). See also, *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 330 F.3d 1333, 66 USPQ2d 1811, 1816 (Fed. Cir.) ("dilution law is intended to protect a mark's owner

⁷³ 37-49 TTABVUE.

from dilution of the mark's value and uniqueness"). Blurring may occur "regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury." *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1298 (TTAB 2016) (quoting 15 U.S.C. § 1125(c)).

To determine whether Applicant's use of its mark is likely to cause dilution by blurring, we consider:

- (i) the degree of similarity between Applicant's mark and Opposer's famous mark;
- (ii) the degree of inherent or acquired distinctiveness of Opposer's mark;
- (iii) the extent to which Opposer is engaging in substantially exclusive use of its mark;
- (iv) the degree of recognition of Opposer's mark;
- (v) whether Applicant intended to create an association with Opposer's KATE SPADE mark; and
- (vi) any actual association between Applicant's mark and Opposer's mark.

15 U.S.C. § 1125(c)(2)(B)(i-vi).

a. Whether the marks are similar

We "consider the degree of similarity or dissimilarity of the marks in their entireties as to appearance, [sound], connotation, and commercial impression." *N.Y. Yankees P'ship*, 114 USPQ2d at 1506 (citing *Research in Motion Ltd. v. Defining Presence Mktg. Grp., Inc.*, 102 USPQ2d 1187, 1198 (TTAB 2012)). We must then determine whether Applicant's mark is sufficiently similar to Opposer's as to "trigger consumers to conjure up" Opposer's mark. *Nike*, 100 USPQ2d at 1030 (quoting *Nat'l*

Pork Bd., 96 USPQ2d at 1497). In other words, Applicant's mark must be close enough to Opposer's KATE SPADE mark that consumers will recall the KATE SPADE mark and be reminded of it "even if they do not believe the goods come from the famous mark's owner." *Nike*, 100 USPQ2d at 1030 (quoting *Toro*, 61 UPSQ2d at 1183).

With this background, we now turn to a consideration of the degree of similarity between Applicant's WOLV and design mark and Opposer's KATE SPADE mark in the dilution context. While we are not concerned in this context with whether a likelihood of confusion exists, we still consider the marks, not on the basis of a side-by-side comparison, but rather in terms of whether the marks are sufficiently similar in their overall commercial impressions that the required association exists. Also, in determining the similarity or dissimilarity of the marks, "we will use the same test as for determining the similarity or dissimilarity of the marks in the likelihood of confusion analysis, that is, the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." *Nike*, 100 USPQ2d at 1030 (quoting *Coach Services*, 96 USPQ2d at 1613).

The same reasoning we used to determine the marks are not similar for purposes of likelihood of confusion applies to our analysis as to whether Applicant's mark is so similar that it trigger consumers to conjure up Opposer's mark. Specifically, the dominance of the word "Wolv" in Applicant's mark and the ornate spade design featuring a highly stylized letter "W" are so different than Opposer's KATE SPADE

mark that consumers viewing Applicant's mark will not call to mind or conjure up Opposer's KATE SPADE mark.

This factor weighs heavily against finding dilution by blurring.

b. Opposer's mark is highly distinctive

Opposer's KATE SPADE mark is highly distinctive. It is a coined, arbitrary mark, highly recognized in fashion circles in the United States. Indeed, as noted above, a KATE SPADE product is one of the first designer products many consumers purchase. Applicant does not dispute that KATE SPADE is highly distinctive.

In any event, "[e]ven if the mark is not viewed as inherently distinctive, we found above that the mark is famous, which necessarily subsumes a finding" that the mark has acquired distinctiveness. *N.Y. Yankees P'ship*, 114 USPQ2d at 1507. *See also, Chanel, Inc. v. Majarczyk*, 110 USPQ2d at 2025 ("In any event, the discussion above regarding opposer's extensive evidence of fame of the CHANEL mark used in connection with clothing, fashion accessories, beauty products and boutiques more than sufficiently establishes that opposer's CHANEL mark has acquired a high degree of distinctiveness among consumers."). This factor weighs in favor of finding dilution by blurring.

c. Opposer use of KATE SPADE is substantially exclusive

There is no evidence that Opposer's use of KATE SPADE is anything other than exclusive. Applicant does not dispute that Opposer's use of the KATE SPADE mark is substantially exclusive.

This factor weighs in favor of finding dilution by blurring.

d. Opposer's KATE SPADE mark is widely recognized in the United States

As we discussed above in the context of the fame of Opposer's KATE SPADE mark, KATE SPADE is widely recognized in the United States. This factor weighs in favor of finding dilution by blurring.

e. Applicant did not intend to create an association with Opposer's KATE SPADE mark

Opposer did not introduce any evidence or argument that Applicant intended to create an association with Opposer's KATE SPADE mark. This factor weighs against finding dilution by blurring.

f. Actual association between Applicant's WOLV and design mark and KATE SPADE mark.

Applicant's application was filed based on its intent to use the WOLV and design mark. There is no evidence that Applicant has made any use of its WOLV and design mark in commerce. Accordingly, there is no evidence of any actual association between Applicant's WOLV and design mark and Opposer's KATE SPADE mark. This factor is neutral.

g. Conclusion

Although Opposer's KATE SPADE mark is distinctive and widely recognized, and Opposer's use of its KATE SPADE mark is substantially exclusive, the similarities between Applicant's WOLV and design mark and Opposer's KATE SPADE mark are insufficient to support a finding of dilution by blurring in light of the prominence of the word portion of Applicant's mark. *See Citigroup, Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1667 (TTAB 2010), *aff'd on other grounds*, 637 F.3d 1344, 98

USPQ2d 1253 (Fed. Cir. 2011) (“[T]he weight given to each of the statutory factors is dependent upon the evidence introduced into the record. Each factor may vary in weight from case to case depending on the facts. ... Thus, there is no prohibition to giving the statutory dilution factors more or less weight depending on the facts.”) (citing *Kellogg Co. v. Pack'em Enters. Inc.*, 21 USPQ2d at 1145).

We dismiss Opposer’s dilution claim.

VII. Whether Applicant had a bona fide intent to use its mark when it filed the application at issue.

“A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register....” Section 1(b)(1) of the Trademark Act, 15 U.S.C. § 1051(b)(1). “A determination of whether an applicant has a bona fide intention to use the mark in commerce is an objective determination based on all the circumstances.” *Boston Red Sox v. Sherman*, 88 USPQ2d 1581, 1586 (TTAB 2008) (citing *Lane Ltd. v. Jackson Int’l Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994)). “Opposer has the initial burden of demonstrating by a preponderance of the evidence that applicant lacked a bona fide intent to use the mark on the identified goods [on the filing date of its application]. The absence of any documentary evidence on the part of an applicant regarding such intent constitutes objective proof sufficient to prove that the applicant lacks a bona fide intention to its use its mark in commerce.” *Id.* at 1587 (citing *Commodore Elec. Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993)). *See also* *Spirits Int’l, B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birliđi*, 99 USPQ2d 1545, 1549 (TTAB 2011); *Boston Red*

Sox Baseball Club, 88 USPQ2d at 1587. If an opposer establishes a prima facie case, the burden shifts to applicant to rebut that prima facie case by producing evidence which would establish that it had the requisite bona fide intent to use the mark when it filed its application. *See Commodore Electronics*, 26 USPQ2d at 1507 . *See also Saul Zaentz*, 95 USPQ2d at 1727.

The evidentiary bar for showing bona fide intent to use is not high, but more is required than “a mere subjective belief.” *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 1892, 1898 (Fed. Cir. 2015). The objective evidence must indicate an intention to use the mark that is “firm” and “demonstrable.” *Id.* In other words, Applicant’s evidence bearing on its bona fide intent must be “objective” in the sense that it is evidence in the form of real-life facts and by the actions of the Applicant, not solely by Applicant’s uncorroborated testimony as to its subjective state of mind. That is to say, Congress did not intend the issue to be resolved simply by an officer of Applicant later testifying, “Yes, indeed, at the time we filed that application, I did truly intend to use the mark at some time in the future.” 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §19:14. *See also Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1394 (Fed. Cir. 1990) (“Nothing in the statute entitles a registrant who has formerly used a mark to overcome a presumption of abandonment arising from subsequent nonuse by simply averring a subjective affirmative ‘intent not to abandon.’”).

Opposer argues that “Applicant lacked firm and demonstrable plans to use the SPADE Wolv Mark at the time it filed the application.”⁷⁴

Despite four years having passed since filing the Application, Applicant still has not decided on an expense budget, the model(s), types, or movement(s) of watch(es) he wants to manufacture, where he wants to manufacture the watches (China or Switzerland), at what price point he will sell the watches, nor has he retained anyone to design or manufacture the watch. Indeed, Mr. Hsu [Applicant’s sole owner and President] testified that he has not taken any steps [sic] pending the outcome of this opposition proceeding. Despite not having the monies to finance the business, Hsu has not sought out investors or other sources of money. Despite not having any training, experience or capacity to run a watch business, Applicant has not sought out any business partners, investors or third parties (other than to render the logo itself).⁷⁵

Mr. Hsu produced what he claims is a “business plan,” which is an undated document that is more accurately described as hopeful assertions, and has no plans for implementation. The “business plan” lacks any real details that would be included in a credible business plan, such as strategies to build a company operational structure, identification as to sources of product parts, packaging and labeling for Applicant’s products, manufacturing and distribution capabilities, or a budget for sales and marketing campaign -- all of which Applicant does not plan to pursue until after securing his trademark registration.⁷⁶

The testimony of Applicant’s Mr. Hsu tells another story. Even though Hsu has no experience making watches, he decided to start a watch company because he is a watch enthusiast.⁷⁷

⁷⁴ Opposer’s Brief, p. 29 (64 TTABVUE 37).

⁷⁵ *Id.*

⁷⁶ *Id.* at p. 30 (64 TTABVUE 38).

⁷⁷ Hsu Discovery Dep., p. 105 (55 TTABVUE 31).

Q. Why a watch company?

A. I'm a watch enthusiast. I love watches. It's my passion. It's my dream to create a watch company.⁷⁸

Hsu owns five or six watches including two Rolex watches, an Invicta, and a Seiko. He considered selling one of Rolex watches to help fund the project.⁷⁹

Hsu testified about the steps he took to bring his watch company to fruition including documents he created. Hsu testified as follows:

- Etienne Ruffeux, an independent contractor, designed a watch clasp for Applicant. He also made sketches for a watch case, dials, crown, bezel, bracelet and watch hands. He helped design the logo and made digital renderings of the sketches Hsu approved, and made electronic 3D models;⁸⁰

- Applicant uses the mark at issue as a “thumbnail for my profile picture on Facebook and Instagram”;⁸¹

- Within “the last two or three years,” Applicant has made a sample box, watch straps, push pins, sample business cards and authentication cards;⁸²

⁷⁸ *Id.*

⁷⁹ *Id.* at p. 71 (55 TTABVUE 23).

⁸⁰ *Id.* at p. 32 (55 TTABVUE 13).

⁸¹ *Id.* at p. 39 (55 TTABVUE 15).

⁸² *Id.* at pp. 40-41 (55 TTABVUE 15-16).

- Within the last “two or three years,” Applicant made a “very basic breakdown of the money that I need to manufacture watches,”⁸³ including the cost for a technical study.⁸⁴

In order to begin the manufacturing process and discussions with Roventa Henex, you need to pay for a technical study, which means that they have engineers look over the designs and redesign anything they need to design, and that’s like the preliminary work that needs to be done, prior to moving forward with manufacturing anything.⁸⁵

- Within the last “two or three years,” Applicant created a “prototype specification detail” for different models of watches so potential watch manufacturers (e.g., Time Star, Roventa Henex, and Walca) can prepare a quote.⁸⁶

Q. So how did you come up with the specifications of each of these styles?

A. These are specifications that I would like to have in the watches that I manufacture.

Q. Are they based on anything else – did you base them on other types of watches?

A. I would look at some watches and look at my wrist and decide if I wanted larger or smaller sometimes, or, like some items you just can’t change. Some items are unchangeable, elements of a watch.

Q. Can you give me some examples of what some of those are?

A. Okay.

⁸³ *Id.* at pp. 62-72 and Exhibit 4 (55 TTABVUE 21-23 and 92).

⁸⁴ *Id.* at p. 66 (55 TTABVUE 22).

⁸⁵ *Id.*

⁸⁶ *Id.* at pp. 72-73 and 76 and Exhibit 5 (55 TTABVUE 23 and 93-96).

If you look at depth rating for a dive watch, to consider a dive watch, it has to be 300 meters depth rating, meaning you could go 300 meters under water without being damaged. The Longitude is not a dive watch, so it doesn't require a 300-meter reading.

For the movements that are being used, Eta 2824-2, the best setting for the best Eta movement is -- has a B error of point 3, and that's the best you can expect in an Eta model. That's something you can't change.⁸⁷

- Hsu Discovery Exhibit 6 comprises “[i]mages of watch renderings and some are images of actual watches or watch parts, and authentication card renderings,” Hsu created within the last two or three years;⁸⁸

- Hsu Discovery Exhibit 7 comprises sample authentication cards that Hsu collected within the last two or three years for inspiration;⁸⁹

- Hsu Discovery Exhibit 8 comprises “a group of pages of renderings, designs, sketches, corrections, notes from different stages of designing,” Hsu and Etienne created around two years earlier;⁹⁰

- Hsu Discovery Exhibits 9 and 10 collectively show “an early rendering of just sketches [Hsu] was making on Photoshop,” other watch models prepared two or three years earlier.⁹¹

- Hsu Discovery Exhibit 12 is “a design of a case back, which is the cover for the back of the watch where the movement is inserted, and it's a design that I created

⁸⁷ *Id.* at p. 74 (55 TTABVUE 24).

⁸⁸ *Id.* at pp. 77-84 and Exhibit 6 (55 TTABVUE 24-26 and 97-106).

⁸⁹ *Id.* at pp. 84-85 and Exhibit 7 (55 TTABVUE 26 and 107-133).

⁹⁰ *Id.* at pp. 88-94 and Exhibit 8 (55 TTABVUE 27-29 and 134-154).

⁹¹ *Id.* at pp. 94-99 and Exhibits 9-10 (55 TTABVUE 29-30 and 155-188).

with a little bit of Ettienne's input, and this was a process of him converting it into Adobe Illustrator format to prepare for 3D rendering," prepared two years prior;⁹²

- With respect to the many sketches and design, Hsu testified as follows:

So if you notice, throughout all of these exhibits, there are many watch sketches and designs and many different watch names. So throughout the design process, I've experimented and entertained many, many different variations of designs and movements and names and colors, styles. And so these are all -- these are specifications for just a few of the ones that -- of the designs that I was entertaining.⁹³

- Hsu Discovery Exhibit 14 is "a general business and advertising plan,"⁹⁴ that is a dynamic document that Hsu "added to two or three years ago."⁹⁵

Above, we discussed the type of evidence necessary to objectively support the bona fides of Applicant's intent to use its mark in commerce. The Board also considers when this evidence came into existence. This is important here because Mr. Hsu testified he created many of the documents within the last two or three years. Applicant filed the application November 4, 2017. Opposer deposed Mr. Hsu November 20, 2019. Because Hsu created documents within the last two or three years, he created them approximately between November 2016 through November 2017.

⁹² *Id.* at pp. 101-102 and Exhibit 12 (55 TTABVUE 30-31 and 192).

⁹³ *Id.* at p. 100 (55 TTABVUE 30).

⁹⁴ *Id.* at pp. 112-120 and Exhibit 14 (55 TTABVUE 33-35 and 197-200).

⁹⁵ *Id.* at p. 117 (55 TTABVUE 34).

In addition, once Opposer filed its Notice of Opposition, Applicant's cessation of preparations to use the mark constitutes a sufficient reason to overcome any inference that Applicant did not have a bona fide intent to use the mark at the time it filed the application. *Cf. Cmty. of Roquefort v. Santo*, 443 F.2d 1196, 170 USPQ 205, 208 (CCPA 1971) (applicant's "subsequent decision to hold further activities in abeyance pending the outcome of the opposition appears to be but a reasonable business precaution and does not demonstrate a lack of intention to market the product commercially upon successful termination of the proceeding."); *Visa Int'l Serv. Assoc. v. Life-Code Sys., Inc.*, 220 USPQ 740, 744 (TTAB 1983) (applicant's "decision to hold further activities in abeyance pending the outcome of the opposition does not demonstrate a lack of intention to market services commercially upon successful termination of the opposition."); *Penthouse Int'l, Ltd. v. Dyn Elecs., Inc.*, 196 USPQ 251, 257 (TTAB 1977) ("[N]onuse of a mark pending the outcome of litigation to determine the right to such use or pending the outcome of a party's protest to such use constitutes excusable nonuse sufficient to overcome any inference of abandonment."). Therefore, Applicant's nonaction subsequent to the May 29, 2018 filing date of the Notice of Opposition is excused.

The particular facts of each case must be carefully considered in their totality, but generally, the strongest documentary proof will have been created prior to, or at the latest on, the filing date of the intent-to-use application. *Cf. Societé des Produits Nestlé S.A. v. Cândido Viñuales Taboada*, 2020 USPQ2d 10893, at *12-13 (TTAB 2020) (citing *Swiss Grill*, 115 USPQ2d 2001, 2009-10) (TTAB 2015) (lack of bona fide

intent to use found where no documentary evidence predated application filing date)). Documents created seven months after the application filing date have been found relevant to, but not dispositive of, the applicant's intent at the time of filing. *Nestlé*, 2020 USPQ2d 10893, at*13 (citing *Swatch*, 108 USPQ2d at 1474 (nonetheless, the Board ultimately found the applicant's bona fide intent lacking)). Correspondence occurring nine to eleven months after the filing date also has been found sufficiently contemporaneous to corroborate other evidence regarding the applicant's bona fide intent as of the application filing date. *Nestlé*, 2020 USPQ2d 10893, at*13 (citing *Lane*, 33 UPQ2d at 1356).

In contrast, a long gap between the filing of an application and the activities asserted to demonstrate bona fide intent tends to undercut an inference that the applicant actually had a bona fide intent to use the mark. *Nestlé*, 2020 USPQ2d 10893, at*13. For example, in *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, the Board discounted evidence of Internet searches and investigations conducted more than two years after the application filing date because they "were not even remotely contemporaneous with the filing of the application." *Id.* at 1587-88. *See also Swiss Grill*, 115 USPQ2d at 2009 (applicant's vague claims about communications, meetings, or events which took place one or two years after the filing date, and which did not relate to the mark in question, were found insufficient to show bona fide intent at the time of filing).

In sum, the Board considers the evidence as a whole, and any clear interrelationships that exist between the several pieces of evidence of record, to

determine whether the evidence, in its totality, establishes a bona fide intent to use the mark for the identified goods. *Cf. West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994). Considering the evidence here in its totality, we find that the documents Hsu created and Opposer introduced in his discovery deposition are sufficiently contemporaneous with the filing date of the application to be relevant in determining whether Applicant had a bona fide intent to use the WOLV and design mark at the time Applicant filed its application.

When we consider Hsu's testimony and all the documents introduced in his discovery deposition in its entirety, we find Applicant had a bona fide intent to use the mark in commerce as of the filing date of the application. We assume *arguendo* that Applicant's business plan standing alone lacks sufficient detail to demonstrate a bona fide intent to introduce watches into the market. The business plan, however, is not the only document going to the question of Applicant's bona fide intent. In addition, Applicant created the following documents:

- A basic budget for starting the project. The budget includes the estimated costs for manufacturing the watches, watch parts, design costs, and a technical study. It also includes Applicant's potential sources for funding;⁹⁶

- A "prototype specification detail" for different models of watches so potential watch manufacturers (e.g., Time Star, Roventa Henex, and Walca) can prepare a quote;⁹⁷ and

⁹⁶ *Id.* at pp. 62-72 and Exhibit 4 (55 TTABVUE 21-23 and 92).

⁹⁷ *Id.* at pp. 72-73 and 76 and Exhibit 5 (55 TTABVUE 23 and 93-96).

- Numerous renderings of watches, watch parts, and other related accessories.⁹⁸

Consequently, the Hsu discovery deposition testimony and accompanying exhibits, taken as a whole, indicate that Applicant had more than subjective hopeful or wishful thinking. Applicant had a rudimentary plan and a reason to believe that it could have watches manufactured to its order and specification and market them in the United States. Considering the totality of the circumstances, the low evidentiary bar, and the objective evidence as it bears on Applicant's subjective intent, this suffices to demonstrate Applicant's bona fide intent to use the mark WOLV and design in commerce.

We dismiss Opposer's claim that Applicant did not have a bona fide intent to use its WOLV and design mark when Applicant filed its application.

Decision: We dismiss the opposition on all grounds asserted.

⁹⁸ *Id.* at pp. 32, 40-41, and Exhibits 6-10 and 12 (55 TTABVUE 13, 15-16, 24-31, 97-188, and 192).